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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/553,108 04/20/00 ELLIS

E GJH-0017

EXAMINER

IM71/0730

EXXONMOBIL RESEARCH & ENGINEERING COMPAN
P O BOX 390
FLORHAM PARK NJ 07932-0390

JOHNSON, J	
ART UNIT	PAPER NUMBER

1764
DATE MAILED:

07/30/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/553,108

Applicant(s)

ELLIS ET AL.

Examiner

Jerry D. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 6-9, 14-21, 34 and 35 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Angevine et al.

Angevine et al, U.S. Patent 6,150,575, teach diesel fuels which have good ignition qualities, good combustion emission performance and good low temperature characteristics are characterized by a cetane number of at least 45, a total aromatics content of 10 to 15 wt.%, a polynuclear aromatics content of less than 11 wt.% and a sulfur content of not more than 50 ppm (abstract). Table 3, columns 4 and 5 of Angevine et al, disclose preferred compositional parameters for the diesel fuel. In Table 4, Example 1, a diesel fuel having 14.0 wt.% total aromatics, 0.6 wt.% polynuclear aromatics, 13 ppm sulfur, IBP 183°C, T10 point 225°C and FBP 360°C is disclosed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10, 11, 25, 26, 28, 29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angevine et al.

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Angevine et al is relied on as cited above, but differ from the instant claims in teaching a maximum total aromatic content of 15 wt.% as opposed to the instantly claimed composition having a minimum total aromatics content of "about 20 wt.%."

It would have been obvious to one having ordinary skill in the art at the time the invention was made to increase the amount of aromatics in the diesel fuel taught by Angevine et to a maximum amount of "about 20 wt.%" based on the reasonable expectation that such a diesel fuel would have similar properties, i.e., good ignition qualities, good combustion emission performance and good low temperature characteristics.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barry et al.

Barry et al, U.S. Patent 6,004,361, teach a diesel fuels comprising a straight run distillate fuel having an end point not greater than 300°C, a cetane number in the range of 55 to 60, a specific gravity not greater than 0.83, a sulfur content not greater than 0.1 wt % and an aromatics content of 18 to 25% (column 2, lines 1-9). The distillation of the fuel is controlled so as to limit the density of the fuel since high densities have been found to contribute significantly to the emission of particulates (column 2, lines 31-33). The final boiling point of the fuels is therefore held below about 315° C and preferably below 300° C. Provided that this limitation is observed, bicyclic and polycyclic aromatics will be substantially excluded (column 2, lines 40-44). The initial boiling points of the fuels is lower than conventional, typically in the range of 170° to 190° C. Ten percent points are typically in the range from about 200° to 220° C (column 2, lines 46-50). The addition of conventional diesel fuel additives are taught in column 3, lines 26+. In Table 1, column 4 of Barry et al, a diesel fuel having 0.01 wt% sulfur and 24 wt% aromatics is disclosed. While Barry et al differ from the instant claims in not specifically disclosing a fuel

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having the claimed combination of properties, it would have been obvious to one having ordinary skill in the art at the time the invention was made to follow the above cited teachings to arrive at the instantly claimed composition.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 09/553,373. Although the conflicting claims are not identical, they are not patentably distinct from each other because, while not of the same scope, the claims of both applications are directed to distillate fuels having the same or overlapping compositional parameters.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-15 of copending Application No. 09/553,107. Although the conflicting claims are not identical, they are not patentably distinct from each other because, while not of the same scope, the claims of both

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applications are directed to distillate fuels having the same or overlapping compositional parameters.

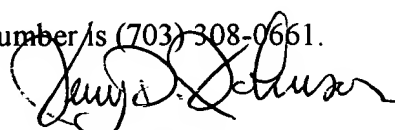
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ
July 26, 2001